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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,974	07/26/2001	Michael Wayne Brown	AUS920010391US1	8171

7590 01/25/2005

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EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/915,974	Applicant(s) BROWN ET AL.	
	Examiner Matthew T Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/26/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

This action is in response to the communication filed on 7/26/2001.

DETAILED ACTION

1. Claims 1-41 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 7/26/2001.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 7/26/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

6. The drawings filed on 7/26/2001 are acceptable for examination proceedings.

Specification

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The abstract of the disclosure is objected to because

Line 3: The phrase “are provided” can be implied and therefore must be removed.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 6-9, 12-15, 18-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoepman et al. (US Patent Number 6,347,373) hereinafter referred to as Hoepman.

11. Regarding claim 1, Hoepman disclosed a method for encrypting a messaging session, said method comprising the steps of (See Hoepman Col 1 Lines 5-16 and Col. 6 Lines 29-44): encrypting a recording of a messaging session with symmetric key, wherein said symmetric key is enabled to decrypt said encrypted recording of said messaging session (See Hoepman Col. 8 Lines 15-20); and encoding said symmetric key with a plurality of public keys each corresponding with one from among a plurality of users, wherein said encoded symmetric key is decodable by each said plurality of users, such that said encrypted recording of said messaging

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session is decryptable by each of said plurality of users utilizing said symmetric key (See Hoepman Col. 8 Paragraph 4).

12. Regarding claim 2, Hoepman disclosed encrypting said recording, and encoding said symmetric key at a messaging server system communicatively connected to a network to a plurality of client messaging systems (See Hoepman Col. 9 Paragraph 9, Fig. 1, and Claim 12).

13. Regarding claim 3, Hoepman disclosed encrypting said recording and encoding said symmetric key at a particular client messaging system communicatively connected to a network to a plurality of client messaging systems (See Hoepman Col. 8 Paragraphs 3-4).

14. Regarding claim 6, Hoepman disclosed distributing said encoded symmetric key according to said plurality of public keys each corresponding with one from among said plurality of users (See Hoepman Col.8 Paragraph 4).

15. Regarding claim 7, Hoepman disclosed distributing said encrypted recording of said messaging session to said plurality of users (See Hoepman Col. 10 Paragraph 1).

16. Regarding claim 8, Hoepman disclosed storing said symmetric key in a secure file only accessible to a selection of said plurality of users and an administrator for said messaging session (See Hoepman Col. 8 Paragraph 4).

17. Claim 9 is rejected for the same reasons as claim 1 above and further because Hoepman disclosed a messaging server communicatively connected to a network to a plurality of client messaging systems each associated with one from among a plurality of users (See Hoepman Fig. 1 and Col. 5 Line 63 – Col. 6 Line 27).

18. Claims 12-14 are rejected for the same reasons as claims 6-8 as applied to claim 9 above.

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19. Claim 15 is rejected for the same reasons as claim 1 above and further because it was inherent that the processor of Hoepman in claims 12-22 was provided with computer readable code in order to have functioned as a processor.

20. Claims 18-20 are rejected for the same reasons as claims 6-8 as applied to claim 15 above.

21. Regarding claim 21, Hoepman disclosed a method for secure messaging session transmission, said method comprising the steps of: receiving a key encoded specifically for a particular user and an encrypted messaging session (See Hoepman Col. 8 Paragraph 4); decoding said key with a private key for said particular user (See Hoepman Col. 7 Paragraph 5); and decrypting said encrypted messaging session with said decoded key, such that said particular user is enabled to receive and securely decrypt said encrypted messaging session (See Col. 10 Lines 1-24).

22. Regarding claim 22, Hoepman disclosed requesting to record a messaging session (See Hoepman Col. 7 Paragraph 2); and in response requesting to record said messaging session, receiving said encrypted messaging session and said key (See Hoepman Col. 9 Paragraph 9 and Col. 10 Lines 33-35).

23. Claims 23-24 are rejected for the same reasons as claims 21-22 and further because Hoepman disclosed a client messaging system communicatively connected to a network (See Hoepman Fig. 1 and Col. 5 Line 63 – Col. 6 Line 27).

24. Claims 25-26 are rejected for the same reasons as claims 21-22 and further because it was inherent that the processor of Hoepman in claims 12-22 was provided with computer readable code in order to have functioned as a processor.

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25. Regarding claim 27, Hoepman disclosed A method for real-time encryption of a message entry transmitted to a plurality of client messaging systems, said method comprising the steps encrypting a message entry with a symmetric key at a client messaging system (See Hoepman Col. 8 Paragraph 3); and transmitting said encrypted messaging entry for distribution to a plurality of recipient client messaging systems, such that said message entry is encrypted with said symmetric key enabled to decrypt said message entry prior to transmission across a network (See Hoepman Col. 8 Paragraph 3).

26. Regarding claim 28, Hoepman disclosed receiving an encoded symmetric key at a client messaging system; and decoding said encoded symmetric key with a private key matching a public key utilized to encode said symmetric key (See Hoepman Col. 7 Paragraph 5).

27. Regarding claim 29, Hoepman disclosed generating said symmetric key at said client messaging system (See Hoepman Col. 7 Paragraph 5).

28. Regarding claim 30, Hoepman disclosed encoding said symmetric key with a plurality of public keys associated with a plurality of users intended to receive said message entry (See Hoepman Col. 7 Paragraph 5); and transmitting said encrypted message entry and said encoded symmetric keys to said plurality of recipient client messaging systems (See Hoepman Col. 7 Paragraph 5 and Col. 8 Paragraph 3).

29. Claims 31-34 are rejected for the same reasons as claims 27-30 and further because Hoepman disclosed a client messaging system communicatively connected to a network (See Hoepman Fig. 1 and Col. 5 Line 63 – Col. 6 Line 27).

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30. Claims 35-38 are rejected for the same reasons as claims 27-30 and further because it was inherent that the processor of Hoepman in claims 12-22 was provided with computer readable code in order to have functioned as a processor.

31. Regarding claim 39, Hoepman disclosed a method for controlling real-time distribution of encrypted messages, said method comprising the steps of: transmitting a symmetric key encoded for a particular user to a client messaging system (See Hoepman Col. 7 Paragraph 5); receiving a message entry from said client messaging system, wherein said message entry is encrypted with said symmetric key (See Hoepman Col. 8 Paragraph 3); encoding said symmetric key to said plurality of intended recipients (See Hoepman Col. 7 Paragraph 5); and transmitting said message entry and said encoded symmetric key to said plurality of intended recipients, such that said encrypted message entry is distributed in real-time to said plurality of intended recipients (See Hoepman Col. 7 Paragraph 5 and Col. 8 Paragraph 3).

32. Claim 40 is rejected for the same reasons as claim 39 and further because Hoepman disclosed a messaging server communicatively connected to a network (See Hoepman Fig. 1 and Col. 5 Line 63 – Col. 6 Line 27).

33. Claim 41 is rejected for the same reasons as claim 39 and further because it was inherent that the processor of Hoepman in claims 12-22 was provided with computer readable code in order to have functioned as a processor.

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 4, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoepman as applied to claims 1, 9, and 15 above, and further in view of Busey et al. (US Patent Number 6,377,944) hereinafter referred to as Busey.

Hoepman disclosed recording a conversation between multiple parties at the request of one of the parties (See Hoepman Col. 6 Line 65 - Col. 7 Line 8), but failed to disclose recoding a selection of the plurality of messages. However, Hoepman did disclose that the recording could begin at any point (See Hoepman Col. 6 Line 65 - Col. 7 Line 8).

Busey teaches that in a system for recording conversations, the recording can be limited to portions of the conversation (See Busey Col. 6 Lines 19-23).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Busey in the conversation recorder of Hoepman by allowing the recording of portions of the conversation. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide a more flexible environment to the users of the system in order to adapt to the users preferences.

36. Claims 5, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoepman as applied to claims 1, 9, and 15 above, and further in view of Schneier ("Applied Cryptography").

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Hoepman disclosed creating a symmetric key (See Hoepman Col. 7 Paragraph 5), but failed to disclose the key comprising alphanumeric, graphic, or audio elements, or how the key is generated. However, Hoepman did disclose the key being random.

Schneier teaches a method for generating a random symmetric key from a pass phrase (See Schneier Page 174), which creates an alphanumeric key.

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Schneier in the key generation of Hoepman by crunching a pass phrase in order to create a random key. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide a method for generating the random key needed by Hoepman.

Conclusion

37. Claims 1-41 have been rejected.

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- a. Ganesan (US patent Number 5,557,678) disclosed a system for encrypting messages using a symmetric key and distributing the key using a public key method.
- b. Smith et al. (US Patent Number 6,061,448) disclosed a system for distributing documents from a server by encrypting them with a symmetric key and sending the symmetric key to the recipient after encrypting it with the recipients public key.
- c. Matsumoto (US Patent Number 6,215,877) disclosed a system for distributing channel keys in a chat server.

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39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Henning
Assistant Examiner
Art Unit 2131

1/19/05



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